

Docket No.: 200936US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/719,554
Applicants: Patrick M. ALLIEL, et al.
Filing Date: January 18, 2001
For: NUCLEIC SEQUENCE AND DEDUCED PROTEIN
SEQUENCE FAMILY WITH HUMAN
ENDOGENOUS RETROVIRAL MOTIFS, AND
THEIR USES
Group Art Unit: 1648
Examiner: Chen, S.B.
Allowed: October 6, 2004

SIR:

Attached hereto for filing are the following papers:

**Petition Under 37 C.F.R. §1.181(a)(3)
Form PTO 1449**

**Copy of Date-stamped Filing Receipt dated December 26, 2000
Copy of International Search Report filed December 26, 2000**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

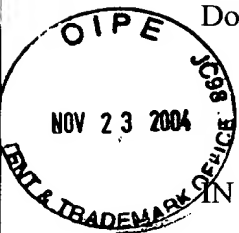
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Vincent K. Shier, Ph.D.
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Docket No.: 200936US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

:

Patrick M. ALLIEL, et al.

: ART UNIT: 1648

SERIAL NO: 09/719,554

: EXAMINER: CHEN, S. B.

FILED: JANUARY 18, 2001

: ALLOWED: OCTOBER 6, 2004

FOR: NUCLEIC SEQUENCE AND DEDUCED PROTEIN SEQUENCE FAMILY WITH
HUMAN ENDOGENOUS RETROVIRAL MOTIFS, AND THEIR USES

PETITION UNDER 37 C.F.R. §1.181(a)(3)

COMMISSIONER FOR PATENTS
Alexandria, VA 22313-1450

SIR:

Petitioners respectfully request the Office to invoke the supervising authority of the Commissioner and consider Petitioners' Amendment Under 37 C.F.R. §1.312, concurrently filed herewith, and also indicate that the references cited in the International Search Report filed on December 26, 2000, have been considered. Petitioners respectfully request that the Examiner acknowledge consideration of same by providing Applicants with an initialed copy of Form PTO-1449 enclosed herewith listing these references. Petitioners submit herewith a copy of the International Search Report as filed on December 26, 2000, along with a copy of the date-stamped filing receipt evidencing the timely filing thereof.

For the reasons given above, this petition should be GRANTED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

A handwritten signature in black ink, appearing to read 'V. Shier', with a long horizontal flourish extending to the right.

Vincent K. Shier, Ph.D.
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Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO.

200936US0PCT

SERIAL NO.

09/719,554

APPLICANT

Patrick M. ALLIEL, et al.

FILING DATE

January 18, 2001

GROUP

1648

U.S. PATENT DOCUMENTS

EXAMINER	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
AA						
AB						
AC						
AD						
AE						
AF						
AG						
AH						
AI						
AJ						
AK						
AL						
AM						
AN						

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION YES NO
AO	WO 98/23755 A	06/04/98	Wipo	
AP	FR 2 737 500 A	02/07/97	France	
AQ	WO 99/02666 A	01/21/99	Wipo	
AR	WO 99/02696 A	01/21/99	Wipo	
AS	WO 99/26972 A	06/03/99	Wipo	
AT				
AU				
AV				

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

AW	Database GenBank. Sequence HSAC 000064, Clone humain BAC RG083M05 de 7q21-7q22, sequence complet. November 17, 1996, XP002118730
AX	ALLIEL, P.M., et al., "SEQUENCES RETROVIRALES ENDOGENES ANALOGUES A CELLE DU NOUVEAU RETROVIRUS MSRV ASSOCIE A LA SCLEROSE EN PLAQUES", Comptes Rendus Des Seances De L'Academie Des Sciences Serie III: Sciences De La Vie., Vol. 321, No. 6, June 1998, pp. 495-499, XP002101380
AY	Database GenBank Sequence AC X93499 mRNA de H. sapiens pour la proteine rab7, February 10, 1997, XP002119234
AZ	ALLIEL, P.M., et al., "RETROVIRUS ENDOGENES ET SCLEROSE EN PLAQUES. II. HERV-7Q", Comptes Rendus Des Seances De L'Academie Des Sciences Serie III: Sciences De La Vie, Vol. 321, No. 10, October 1998, pp. 857-863, XP002101381

☒ Additional References sheet(s) attached

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO.

200936US0PCT

SERIAL NO.

09/719,554

APPLICANT

Patrick M. ALLIEL, et al.

FILING DATE

January 18, 2001

GROUP

1648

LIST OF REFERENCES CITED BY APPLICANT

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

MITANI, M., et al., "SUPPRESSIVE EFFECT ON POLYCLONAL B-CELL ACTIVATION OF A SYNTHETIC PEPTIDE HOMOLOGOUS TO A TRANSMEMBRANE COMPONENT OF ONCOGENIC RETROVIRUS", Proceedings of the National Academy of Sciences of USA, Vol. 84, No. 1, January 1987, pp. 237-240, XP002118729

AAA

AAB

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AAE

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AAK

AAL

AAM

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AAO

AAP

AAQ

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



O.S. & M. File No. 200936US0PCT By NFO/dty FF Due Date 12/23/00

Serial No. New U.S. PCT Application based on PCT/FR99/01513

In the Matter of the Application of Patrick M. ALLIEL, et al.

For NUCLEIC SEQUENCE AND DEDUCED PROTEIN SEQUENCE FAMILY
WITH HUMAN ENDOGENOUS RETROVIRAL MOTIFS, AND THEIR USES

The following has been received in the U.S. Patent Office on the date stamped hereon:

☒ 69 pgs. Specification 37 Claims (English Translation) 84 Sequence Listing

☐ Combined Declaration, Petition & Power of Attorney (pages)

☐ Petition of Revive Under 37 C.F.R. 1.137 (b)

☒ Notice of Priority;

☒ Check for \$ 1,536.00 ;

☒ Dep. Acct. Order Form

☐ Assignment pages/PTO-1595

☒ Drawings 64 sheets

☒ PCT Transmittal Letter

☒ Preliminary Amendment

☒ PCT/IB/304

☒ PCT/IB/308

☐ International Preliminary Examination Report

☐ Information Disclosure Statement; ☐ PTO-1449

☐ Cited References ()

☐ Statement of Relevancy

☐ List of Related Cases

☐ Cited Pending Applications (#)

☒ International Search Report

☒ Request for Consideration of Documents Cited in International Search Report

☐ Letter Regarding Translation of Annexes

☐ Translation of Annexes to International Preliminary Examination Report

SERIAL NO. 09/719554

DATE RECEIVED 60 Rec'd PCT/PTO 26 DEC 2000

☐ CLAIMING SMALL ENTITY STATUS

COPY

INTERNATIONAL SEARCH REPORT

International Application No

PCT/FR 99/01513

A. CLASSIFICATION OF SUBJECT MATTER

IPC 6 C12N15/48 C12Q1/70 C07K14/15 A61K31/70

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 6 C12N C12Q C07K A61K

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	WO 98 23755 A (BIO MERIEUX) 4 June 1998 (1998-06-04) Comparez nucléotides 1-1462 de SEQ ID NO:117 avec nucléotides 928-2390 de SEQ ID NO:1 de la présente demande; comparez SEQ ID NO:118 avec SEQ ID NOs:22 et 120 de la présente demande ---	1,3-12, 14-36
X	Database GenBank. Séquence HSAC 000064 Clone humain BAC RG083M05 de 7q21-7q22, séquence complet. 17 novembre 1996. XP002118730 Comparez nucléotides 28000-38500 d' AC00064 avec SEQ ID NO:3 --- -/-	1-4,13

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents :

- *A* document defining the general state of the art which is not considered to be of particular relevance
- *E* earlier document but published on or after the international filing date
- *L* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- *O* document referring to an oral disclosure, use, exhibition or other means
- *P* document published prior to the international filing date but later than the priority date claimed

T later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

X document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

Y document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

Z document member of the same patent family

Date of the actual completion of the international search

18 October 1999

Date of mailing of the international search report

11.11.99

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Cupido, M

INTERNATIONAL SEARCH REPORT

International Application No

PCT/FR 99/01513

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	<p>ALLIEL PM ET AL: "Séquences rétrovirales endogènes anlogues à celle du nouveau rétrovirus MSRV associé à la sclérose en plaques (première partie)"</p> <p>COMPTES RENDUS DES SEANCES DE L'ACADEMIE DES SCIENCES SERIE III: SCIENCES DE LA VIE.,</p> <p>vol. 321, no. 6, June 1998 (1998-06),</p> <p>pages 495-499, XP002101380</p> <p>MONTREUIL FR</p> <p>figures 2,3</p> <p>---</p>	1,3-12, 14-36
X	<p>Database GenBank Séquence AC X93499</p> <p>mRNA de H. sapiens pour la protéine rab7</p> <p>10 février 1997</p> <p>XP002119234</p> <p>& VITELLI R ET AL: "Molecular cloning and expression analysis of the human rab7 GTP-ase complementary deoxyribonucleic acid"</p> <p>BIOCHEMICAL AND BIOPHYSICAL RESEARCH COMMUNICATIONS,</p> <p>vol. 229, no. 3, 1996, pages 887-890,</p> <p>ORLANDO, FL US</p> <p>---</p>	1-4
X	<p>FR 2 737 500 A (BIO MERIEUX)</p> <p>7 February 1997 (1997-02-07)</p> <p>cited in the application</p> <p>the whole document</p> <p>---</p>	1,3-12, 14-36
P,X	<p>WO 99 02666 A (BIO MERIEUX)</p> <p>21 January 1999 (1999-01-21)</p> <p>Comparez SEQ ID NOs 130, 117, 114 et 120 avec SEQ ID NOs: 1-3 de cette demande et SEQ ID NO:118 avec SEQ ID NOs:22 et 120 de cette demande</p> <p>---</p>	1,3-12, 14-36
P,X	<p>WO 99 02696 A (BIO MERIEUX ;BESEME FREDERIC (FR); BLOND JEAN LUC (FR); BOUTON OLI) 21 January 1999 (1999-01-21)</p> <p>Comparez SEQ ID NOs: 4, 5, 7, 9 et 11 avec SEQ ID NOs: 1-3 de cette demande.</p> <p>---</p>	1,3-12, 14-36
P,X	<p>ALLIEL PM ET AL: "Rétrovirus endogènes et sclérose en plaques. II. HERV-7q"</p> <p>COMPTES RENDUS DES SEANCES DE L'ACADEMIE DES SCIENCES SERIE III: SCIENCES DE LA VIE.,</p> <p>vol. 321, no. 10, October 1998 (1998-10),</p> <p>pages 857-863, XP002101381</p> <p>MONTREUIL FR</p> <p>the whole document</p> <p>---</p> <p>-/--</p>	1,3-12, 14-36

INTERNATIONAL SEARCH REPORT

International Application No.

PCT/FR 99/01513

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT		
Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
P,X	WO 99 26972 A (GENETICS INSTITUTE, INC.) 3 June 1999 (1999-06-03) comparez SEQ ID NO:4 avec a.a. 131-668 de séquence 22 de cette demande ---	1-4
A	MITANI M ET AL: "Suppressive effect on polyclonal B-cell activation of a synthetic peptide homologous to a transmembrane component of oncogenic retrovirus" PROCEEDINGS OF THE NATIONAL ACADEMY OF SCIENCES OF USA, vol. 84, no. 1, January 1987 (1987-01), pages 237-240, XP002118729 WASHINGTON US cited in the application the whole document -----	24,25

INTERNATIONAL SEARCH REPORT

International application No.

PCT/FR 99/01513

Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☐ Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

2. ☒ Claims Nos.: 8
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

See supplementary sheet INFORMATION FOLLOW-UP PCT/ISA/210

3. ☐ Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

See supplementary sheet

1. ☐ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.
2. ☒ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
3. ☐ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:

4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

☐

The additional search fees were accompanied by the applicant's protest.

☐

No protest accompanied the payment of additional search fees.

The International Searching Authority found several (groups of) inventions in the international application, namely:

1. Claims: 1, 9, 21-23, 26 (wholly), 28, 10-20 and 27-37 (partly)

Nucleic acid fragments derived from HERV-7q env, diagnostic reagents, diagnostic applications and kits, peptides, pharmaceutical compositions and applications, antibodies and corresponding transgenic animals.

2. Claims: 2-7, 10-20, 27-37 (all partly)

Nucleic acid fragments derived from HERV-7q gag, diagnostic reagents, diagnostic applications and kits, peptides, pharmaceutical compositions and applications, antibodies and corresponding transgenic animals.

3. Claims: 2-7, 10-20, 27-37 (all partly)

Human nucleic acid fragments similar to HERV-7q gag, diagnostic reagents, diagnostic applications and kits, peptides, pharmaceutical compositions and applications, antibodies and corresponding transgenic animals.

4. Claims: 24, 25

Compositions comprising a CKS-type motif, inasmuch as said compositions do not contain a sequence as per the first invention.

Continuation of Box I.2

Claim No: 8

Claim 8 concerns a very wide variety of compounds. A support basis as defined in PCT Article 6 and a description as defined in PCT Article 5 can however be found for only a very limited number of the claimed compounds. In the present case, the claims are so lacking in support basis and the disclosure of the invention in the description is so limited that it is impossible to carry out any significant search concerning the whole claimed spectrum.

The applicant's attention is drawn to the fact that claims concerning inventions in respect of which no search report has been established need not be the subject of a preliminary examination report (PCT Rule 66.1 (e)). The applicant is warned that the guideline adopted by the EPO acting in its capacity as International Preliminary Examining Authority is not to proceed with a preliminary examination of a subject matter unless a search has been carried out thereon. This position will remain unchanged, notwithstanding that the claims have or have not been modified, either after receiving the search report, or during any procedure under Chapter II.

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/FR 99/01513

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
WO 9823755	A	04-06-1998	EP 0942987 A	22-09-1999
FR 2737500	A	07-02-1997	AU 6823296 A	05-03-1997
			BG 101355 A	30-12-1997
			BR 9606566 A	30-12-1997
			CA 2201282 A	20-02-1997
			CZ 9701357 A	17-06-1998
			EP 0789077 A	13-08-1997
			WO 9706260 A	20-02-1997
			HU 9900425 A	28-05-1999
			JP 11502416 T	02-03-1999
			NO 971493 A	03-06-1997
			NZ 316080 A	29-04-1999
			PL 319512 A	18-08-1997
			SK 56797 A	09-09-1998
WO 9902666	A	21-01-1999	FR 2765588 A	08-01-1999
			AU 8545098 A	08-02-1999
WO 9902696	A	21-01-1999	AU 8447098 A	08-02-1999
WO 9926972	A	03-06-1999	AU 1417899 A	15-06-1999